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Patent and Trademark Office

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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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09/014,518 01/28/98 THOMPSON

R 5355-RE02

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IM71/1210

EXAMINER

GRAY, J

ART UNIT	PAPER NUMBER
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1774

2012

DATE MAILED:

12/10/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on _____
- ☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-17 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-9 is/are allowed.
- ☒ Claim(s) 10-17 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- ☐ Certified copies not received: _____
- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Informational, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

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DETAILED ACTION

Response to Amendment

In response to applicant's request for clarification regarding the number of pending claims in both the Reexamination and Reissue applications, applicant's preliminary amendments filed May 28, 1998 have been received and entered into both applications. However, it is noted that while both preliminary amendments were directed to "housekeeping" due to the merged proceedings, the preliminary amendment to the Reexamination amends claims 1-9 and adds claims 10 and 11. Further, this preliminary amendment references that claims 1-11 are pending. Applicants' should note that an amendment filed on January 26, 1998, in the Reexamination cancels claim 3 and adds claims 10-16. The preliminary amendment filed due to the merged proceedings for "housekeeping" purposes does not appear to have taken into account the prior amendment filed.

Response to Amendment

The rejection of claims 1-9 and 12-15 under 35 U.S.C. 251 as being broadened in a reissue application has been withdrawn in view of applicants arguments.

The rejection of claims 1, 10-12 and 14 under 35 U.S.C. 112, first paragraph is moot in view of applicants amendments to the specification.

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The rejection of claims 10 and 11 under 35 U.S.C. 102(b) as being anticipated by "Counter-Maid" printed product brochures is withdrawn upon further consideration by the examiner. In particular, these printed product brochures do not specifically disclose the length and width of the disclosed flexible cutting mat.

The rejection of claim 10 under 35 U.S.C. 102(a) as being anticipated by UK Patent Publication No. GB 2248177 has been withdrawn based upon further consideration by the examiner. In particular, the publication does not teach the length and width required for anticipation.

The rejection of claims 1-9 and 12-15 under 35 U.S.C. 102(b) based upon a public use or sale of the invention ("CounterMaid" product) has been withdrawn in view of applicants' arguments. There is no clear evidence of record of the sale of the "CounterMaid" product in thickness ranges essentially as claimed by applicants. The thickness ranges of the present invention, as amended by applicants, are greater than the known thickness of the "CounterMaid" product. It should be noted that while there is evidence of inquiry regarding sheets of plastic of dimensions within applicants range, there is no factual evidence of record of public use or sale, within the meaning of the statutes, of that which is known as the "CounterMaid" product having dimensions within the presently claimed range.

The rejection of claims 1-9 and 14-15 under 35 U.S.C. 102(b) based upon a public use or sale of the invention (by applicant) has been withdrawn in view of applicants' arguments. An impermissible sale has occurred if there was a definite sale or offer to sale, more than 1 year

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before the effective filing date of the U.S. application. In the present case, the claimed thickness values are supported within the broad range of .008-.030 inches set forth in the parent application, thus according an effective filing date prior to the date of sale.

The rejection of claims 1-9 under 35 U.S.C. 102(f) has been withdrawn in view of applicants' arguments. While it is the position of the examiner that the communication of the "CounterMaid" product was sufficient to enable one of ordinary skill in the art to construct and successfully operate the "CounterMaid" product, it is also the examiner's position that these claims, as amended are limited to a thickness range greater than that of the "CounterMaid" flexible cutting mat. Accordingly, there is no anticipation of the present claims, thus the present claimed invention is not the "same invention" as the "CounterMaid" product, as required for derivation.

The rejection of claims 1-9 and 12-15 under 35 U.S.C. 103(a) as being unpatentable over UK Patent Publication No. GB 2248177 in view of Modern Plastics Encyclopedia (October 1991 issue) has been withdrawn in view of applicants arguments. In particular, the publication teaches a thickness that is greater than that of these claims as amended.

The rejection of claims 1-8 and 12-15 under 35 U.S.C. 103(a) as being unpatentable over the Rosmat printed brochures, in view of "Modern Plastics Encyclopedia" and "VITRPAD" product data information sheets, Stanley Smith & Co., Plastics Ltd. and Amari product information brochures has been withdrawn in view of applicants arguments. In particular, there is

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no clear suggestion in the secondary references to choose the specific plastics material having the specific properties set forth in these claims.

1. The amendment filed September 24, 1998 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Line 6, "assume" and line 21 "produce". It is

not clear as to whether applicants are intending to correct additional deficiencies in the specification.

Applicant is required to cancel the new matter in the reply to this Office action.

Reissue Applications

2. Claims 10 and 11 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. The mean-plus-function language of "hardness means and thickness means", "flexibility means" and "means for resisting curling" results in claims wherein the hardness, flexibility and thickness are not properties of the polymer nor sheet formed therefrom, but can result from separate additional components such as a layer of sheet metal or paneling.

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Claim Rejections - 35 USC § 112

3. Claims 14-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More specifically, the limitation of a thickness between 0.015 and 0.030 inches (claims 14 and 15) and 0.030 and 0.040 inches (claims 16 and 17) is new matter because the specification, while disclosing a broad thickness range of 0.008 inches to 0.060 inches provides no suggestion or guidance as to the narrower range as claimed by applicants. A narrower claim can be objectionable as based on subject matter not disclosed in the application as filed, since the statutory prohibition against new matter applies to narrowing as well as broadening disclosure.

Ex parte Bachelder et al. 131 USPQ 38.

4. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More specifically, claims 10 and 11 are indefinite because the limitations drawn to the “thickness means”, “hardness means” and “flexibility means” are limitations associated with the properties of the sheet and polymer. The subject matter defined by the invention, when read in light of the specification, embraces specific physical properties of the polymer. It is not clear as to how a physical property, such as Rockwell hardness, constitutes a “means” within the definition

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of "means-plus-function" language. Furthermore, the requisite flexibility would be an inherent property of a polymeric sheet of the claimed critical dimensions and hardness, hence, this also would constitute a property of the sheet. Accordingly, the subject matter defined by the invention of claims 10 and 11 is indefinite because the metes and bounds of that which applicants regard as their invention is not clear.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by the Allied Resinous product information, Exhibit 14, pages 232, 233 and 241, essentially for reasons of record.

The Allied Resinous printed product information discloses sheets of a plastic material in thicknesses as thin as 0.020 inches and in sheet sizes having a width greater than six inches and a length greater than ten inches. In addition, the product information discloses a flexural modulus and a Rockwell hardness range which inherently would result in a sheet having means for resisting curling when placed on a flat surface, hardness means and thickness means for inhibiting perforation by a knife when food articles are cut upon it, and flexibility means for accommodating flexure of said sheet into an arcuate trough shape having sufficient cantilever beam strength when

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flexed around a longitudinal centerline. Regarding the language of "for food preparation" it is the examiner's position that this language in the preamble is functional language which adds no patentable weight to the sheet.

Therefore, the disclosure of the Allied Resinous printed product information anticipates the flexible cutting sheet of claim 11.

7. Claims 10 and 11 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention, essentially for reasons of record.

More specifically, the "Counter-Maid" printed product brochures disclose a flexible cutting sheet and method for using said flexible cutting sheet for food preparation, said method steps being essentially as claimed by applicants. This flexible cutting sheet is of the claimed critical dimensions and inherently has the requisite Rockwell hardness. As to the flexural modulus it is the examiner's position that the flexural modulus of the "Counter-Maid" product would have rendered obvious the flexural modulus of the present claimed invention. As such, the method of using the "Counter-Maid" product fully anticipates and renders obvious the present claimed invention of claims 10-11.

The declaration of William Fishman, Exhibit 7, pages 30-34, establishes that in 1980, the inventor of the "Counter-Maid" product contacted him for a joint attempt to market this product and that in 1981 extending into 1982, the "Counter-Maid" product was offered for sale and sold in various retail outlets in California.

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It is the position of the examiner that "[a]ny 'non-secret' use of an invention by someone unconnected to the inventor, such as someone who has independently made the invention, in the ordinary course of business for trade or profit may be a 'public use,'" *Bird Provisions Co. v. Owens Country Sausage*, 197 USPQ 134, 138-40. In the instant case, the method of using the "Counter-Maid" product fully anticipates and renders obvious the present claimed invention.

Therefore, it can be construed that inventor of the "Counter-Maid" product and method of using said product had independently made that which applicants' regard as their invention and resulted in a 'non-secret' use of said invention in the ordinary course of business for trade or profit, thus constituting public use.

In the alternative, it is the examiner's position that "[a]n impermissible sale has occurred if there was a definite sale or offer to sell, more than 1 year before the effective filing date of the U.S. application and the subject matter of the sale, or offer to sell, fully anticipated the claimed invention or would have rendered the claimed invention obvious by its addition to the prior art."

Ferag AG v. Quipp Inc., 33 USPQ2d 1512, 1514 (Fed. Cir. 1995). In addition, it is the examiner's position that "merely offering to sale a product by way of an advertisement or invoice may be evidence of a definite offer for sale or a sale of a claimed invention even though no details are disclosed" and "[s]ale or offer for sale of the invention by an independent third party more than 1 year before the filing date of applicant's patent will bar applicant from obtaining a patent."

MPEP 2133.03(b) Clearly the declaration of William Fishman in combination with the "Counter-

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Maid" printed product brochures establish a definite offer to sell, thereby resulting in an impermissible sale.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent

Publication No. GB 2248177 in view of Modern Plastics Encyclopedia (October 1991 Issue)

(hereinafter "Modern Plastic"), essentially for reasons of record.

As set forth previously, the publication teaches a method for using a flexible cutting mat for food preparation and flexible cutting mat comprising providing a sheet of flexible resilient plastic material of the type set forth by applicants, placing said mat on a flat surface, cutting a food article on said mat using a knife, forming the mat into a guide channel, lifting the mat and tipping the food pieces along the guide channel into a clean receptacle or waste. In addition, the publication teaches that the plastic material can be polypropylene and has a thickness in the range of .8mm and 2.0mm (.0315 inches - .079 inches). The publication is silent as to the specific properties of the plastic material such as Rockwell hardness and flexural modulus.

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"Modern Plastics" discloses commercially available unfilled polypropylene having a Rockwell hardness in the range of R80-R102 for homopolymer polypropylene and R65-R96 for copolymer polypropylene and flexural modulus values in the range of 170,000-250,000 psi for homopolymer polypropylene and 130,000-200,000 psi for copolymer polypropylene.

While the publication is silent as to the specific type of polypropylene contemplated, it is the examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made, to use any commercially available polypropylene known in the art, such as polypropylene of the claimed critical hardness and flexural modulus, with the reasonable expectation of success of producing a flexible cutting mat having lay-flat characteristics and sufficient cantilever beam strength such that it can be used for cutting and handling food articles. Moreover, the skilled artisan would immediately envisage this flexible cutting mat used in the method steps contemplated by the Publication.

Regarding the dimensions of the flexible mat, these would have been obvious to modify commensurate with the desired end use. Furthermore, changes in size and shape are not construed to be a matter of invention. In addition, it is the examiner's position that the teaching of a thickness of .0315 inches is sufficiently close to applicant's claimed thickness of 0.030 inches that one skilled in the art would have expected the mats to have the same properties.

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Response to Arguments

10. Applicant's arguments filed September 21, 1998 have been fully considered but they are not persuasive.

Rejection of claims 10 and 11 under 35 U.S.C. 251

Applicants argue that the use of means-plus-function format invokes the limitation of section 112, sixth paragraph that the element shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. In addition, applicants argue that the recitations of "hardness means and thickness means," "flexibility means", and "means for resisting curling" in claims 10 and 11 must be construed to cover those features of the material disclosed in the specification that perform the recited functions, further arguing that the specification identifies certain properties of the sheet, such as its Rockwell hardness, flexural modulus and thickness that perform the recited functions.

In this regard, it is the position of the examiner that while the aforementioned recitations of claims 10 and 11 must be construed to cover those features of the material disclosed in the specification that perform the recited functions, they are not so limited. In fact, claims 10 and 11 are not limited to that which is specifically disclosed in the specification, but includes "equivalents thereof", thus providing a broader range of possible hardness means, thickness means, flexibility means and mean for resisting curling. Accordingly, it is the position of the examiner that means-plus-function claims 10 and 11 enlarge the scope of the claims and thus constitute a broadening reissue outside the two year statutory period.

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Rejection of claims 14-17 under 35 U.S.C. 112, first paragraph

Applicants argue that the holding of Batchelder, which involved an invention in the chemical arts, is not applicable to an invention that is an article of manufacture and/or a method of use. Applicants further argue that the analysis for whether a narrowed claim introduces new matter must take into account whether one skilled in the art would consider the narrowed ranges inherently supported by the original disclosure, citing In re Wertheim.

In this regard, it is the examiner's position that the holding of Batchelder is in fact applicable since it provides a basis of that which can be construed to be new matter, which applies to any manner of technology, including the arts that embrace articles of manufacture and/or methods of use. In addition, while one must take into account whether the narrowed ranges are inherently supported by the original disclosure, one cannot arbitrarily pick and choose any values within a broad range when there is no suggestion or guidance as to the narrower range. In the present case, there is no suggestion or guidance by way of specific disclosure thereof, such as preferred embodiments, or Experimental examples drawn thereto or of other thickness sufficiently close as to render obvious the thickness ranges set forth in these claims such as 0.015 or 0.040 inches.

Rejection of claims 10 and 11 under 35 U.S.C. 112, second paragraph

Applicants argue that "[w]ith regard to whether a physical property can constitute a means within the meaning of section 112, sixth paragraph, Patent Owner is unaware of any case law or other authority to the contrary", further arguing that the statute provides that the element recited

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in the claim 'shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.' Thus, for example, a 'thickness means for inhibiting perforation by a knife...' should be construed to cover the structure and material and their equivalents, e.g. a plastic sheet having the thickness described in the specification that performs the recited function of inhibiting perforation by a knife."

In this regard, it is the examiner's position that the subject matter defined by the invention is not clearly defined. In the present case, the elements recited in the claims, such as hardness means, when read in light of the specification, is the Rockwell hardness of the plastic material which is a physical property of the plastic. This does not constitute a structure, nor a material nor an act. (Note, the material would be the plastics material per se, not the physical property of said material). The consideration of an equivalent would not necessarily lead one skilled in the art to plastics materials of equivalent Rockwell hardness, rather, would result in ambiguity as to what would constitute an equivalent hardness means, such as embedding sheet metal or reinforcing fabric in the plastic material, which inhibits perforation by a knife. Accordingly, it is the examiner's position that claims 10 and 11 are indefinite because the metes and bounds for which patent protection is being sought is not clearly defined.

Rejection of claims 10 and 11 under 35 U.S.C. 102(b) over Rosmat brochures

Applicants argue that nothing in the Rosmat brochure discloses or suggests a hardness or flexibility range and that there is no evidence that all such mats can, when flexed into this shape, inherently support an article weighing at least five ounces at a distance of at least ten inches from

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the end at which the mat is held, and that there is no evidence that all such mats have no tendency to curl when placed on the flat surface. In addition, applicants argue that there is no evidence that the mat described in the Rosmat brochure has physical properties equivalent to the physical properties described in the specification and imported into claims 10-11 via the application of section 112, sixth paragraph.

In this regard, it is the position of the examiner that one construing mean-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material or acts equivalent therein and equivalents thereof, to the extent that the specification provides such disclosure. *In re Donaldson*, 29 USPQ2d 1845. However, it is the examiner's position that applicants interpretation of section 112 sixth paragraph is unduly limiting. In particular, 35 U.S.C. Section 112, paragraph sixth states that "an element in a claim for a combination may be expressed as a mean or step for performing a specified function without the recital of a structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material or acts described in the specification *and equivalents thereof*." (Emphasis added). The Rosmat printed brochures teach being made from "a special grade of flexible polypropylene, a resilient long lasting and clean material which ensures the minimum blunting of knives when cutting or chopping and being flexed enables the chef to use the mat to funnel the chopped produce straight into a container or saucepan" and that it "will not crack or warp and can't blunt knives". The Rosmat brochures suggests a combination of properties with respect to the utility of specific polypropylene due to its properties of flexibility,

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and a toughness that ensures minimum blunting of knives and flexibility which enables funneling chopped food articles into a given receptacle. Accordingly, it is the examiner's position that the disclosure of "a special grade of flexible polypropylene" which "ensures the minimum blunting of knives when cutting" and "being flexed that enable the chef to use the mat to funnel the chopped produce straight into a container" clearly suggests a hardness means and thickness means for inhibiting perforation by a knife when food articles are cut upon it, and flexibility means having sufficient cantilever beam strength when flexed around a longitudinal centerline and held proximate a first end to support an article spaced at least ten inches from said first end weighing at least five ounces", and is equivalent to applicant's plastic material of Rockwell hardness, thickness and flexural modulus as disclosed in the specification .

As to the assertion that there is no evidence that all such mats have no tendency to curl when placed upon a flat surface, the examiner agrees within the broad spectrum of "all mats". However, as it relates to the specific flexible cutting mat disclosed by the Rosmat brochures, it is the examiner's position that the teaching of "will not crack or warp" clearly suggests an equivalence to applicants' "lay flat" characteristics.

Rejection of claim 11 under 35 U.S.C. 102(b) over Allied Resinous

Applicants argue that it is unclear as to whether the examiner is properly construing claims 10 and 11 in accordance with section 112, sixth paragraph, further arguing that the examiner suggests that she believes that the Allied Resinous sheet would have some means for achieving the functions recited in the present claims but does not explain what those means are,

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further arguing that the examiner does not similarly explain how the Allied Resinous sheet has the other means disclosed in the specification or their equivalents that apply to the claims via section 112, sixth paragraph and that nothing in the Allied Resinous product information inherently discloses that the sheet has the recited cantilever beam strength.

In this concern, it is the position of the examiner that the means in the Allied Resinous product is no more than those means construed by applicant when the claims are read in light of the specification and when, as argued by applicant, 112 sixth paragraph is applied, this embraces all "imported from the specification and equivalents thereof." Accordingly, when the limitations are imported from the specification, they necessarily are those physical properties of the plastic such as Rockwell hardness, flexural modulus and thickness. Applicants' positioning on this is unclear because prior statements and arguments appear to imply a reliance upon the physical properties as a means.

Regarding applicants' argument that the examiner does not explain how the Allied Resinous sheet has the other means disclosed in the specification or their equivalents that apply to the claims via section 112, sixth paragraph, applicants' have stated on the record that "[t]he statute provides that the element recited in the claim 'shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof'. Thus, for example, a 'thickness means for inhibiting perforation by a knife...' should be construed to cover the structure and material and their equivalents, e.g., a plastic sheet having the thickness described in the specification that performs the recited function of inhibiting perforation by a

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knife", (page 12 of the amendment). The Allied Resinous printed product information discloses plastic sheets having a thickness within the ranges disclosed by applicants, said plastic sheets being produced from a plastic material having a Rockwell hardness equally within the range contemplated by applicants. As a result, Allied Resinous teaches a plastic sheet having a Rockwell hardness and thickness described by applicants that preforms the recited function of inhibiting perforation by a knife. Moreover, Allied Resinous teaches that the sheets have a flexural modulus within the range disclosed by applicants and described that results in a sheet that may be easily bent around its longitudinal centerline and held at one end. In addition, it is the examiner's position that the combined hardness means and thickness means of the Allied Resinous material inherently results in a sheet having means to resist curling when placed on a flat surface. Therefore, it is the examiner's position that the teachings of the Allied Resinous printed product information anticipate the flexible cutting sheet. Furthermore, because the Allied Resinous printed product information teaches a plastic sheet having a width greater than six inches and a length greater than ten inches as contemplated by applicants, also teaching a hardness means and thickness means for inhibiting perforation by a knife which inherently results in means for resisting curling when placed on a flat surface, and flexibility means for accommodating flexure of said sheet into an arcuate trough shape, it is the examiner's position that the plastic sheet of Allied Resinous inherently has sufficient cantilever beam strength when flexed around a longitudinal centerline such as to support an article spaced at least ten inches from said end weighing at least five ounces.

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Rejection of claims 10 and 11 under 35 U.S.A. 102(b), public use or sale

Applicants argue that to support a rejection under section 102(b), each and every limitation recited in the claim must be disclosed in the prior art reference, exactly. Applicant also argues that the evidence of record establishes that the "Counter-Maid" mat has a thickness of about 0.0085-0.009 inches and that none of the claims recite a thickness range that encompasses the thickness of the "Counter-Maid" mat. In addition, applicant argues that independent claims 10 and 11 include similar limitations as claims 1 and 6 recited in means-plus-function format and that the "Counter-Maid" mat that was sold or offered for sale did not have the thickness recited in any of the claims and therefore, the claims cannot be anticipated.

In this regard, the rejections against claims 1-9 and 12-15 has been addressed previously and withdrawn. As it relates to claims 10 and 11, it is the examiner's position that these claims are not limited to a plastics material having a thickness between 0.010 and 0.030 inches or 0.010 and 0.060 inches as implied by applicants. As it has been stated on the record, a means-plus-function claim "shall be construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof." Accordingly, in view of the specification, the language in claims 10 and 11 of "thickness means for inhibiting perforation by a knife when food articles are cut upon it" embraces thicknesses as low as 0.008 inches and its equivalents. It has been established that the "Counter-Maid" mat has a thickness of 0.0085-0.009 inches. This is within the range contemplated by the thickness means of claims 10 and 11. Therefore, it is the examiner's position that the thickness means in the "Counter-Maid" mat that inhibits perforation

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by a knife when food articles are cut upon it, is the same or equivalent to the thickness means described by applicants as performing the function of inhibiting perforation by a knife when food articles are cut upon it. It should also be noted that it has been established on the record that the "Counter-Maid" mat has flexibility means to support an article weighing at least 5 ounces spaced 10 inches from the end. Thus, it is the examiner's position that claims 10 and 11 are anticipated by the "Counter-Maid" mat resulting in an impermissible public use or sale of that which applicants regard as their invention.

Rejection of claims 10 and 11 under 35 U.S.C. 102(f)

Applicants argue that although the present inventor, Roderick Thompson admitted that the deficient he perceived in the "Counter-Maid" product spurred him to make the improved cutting mat of the present claims, this does not amount to "derivation" under section 102(f). In addition, applicants argue that to support unpatentability on the basis of derivation, it must be shown that another person had previously made the same invention and communicated it to the named inventor, further arguing that the claimed cutting mat is not the same invention as the "Counter-Maid" mat.

In this regard, it is the examiner's position that the "Counter-Maid" mat is the same as or equivalent to the cutting sheet of claims 10 and 11, thus derivation is applicable. Furthermore, while applicant may not have been able to determine the type of material from which the "Counter-Maid" mat was made and may have made some improvements thereto, the claims are not limited to that which may constitute the improvement and, said improvements do not preclude

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the clear showing of equivalence within the meaning of 35 U.S.C. 112, sixth paragraph, of the "Counter-Maid" mat. The plastics material forming the "Counter-Maid" mat had a hardness means and thickness means to inhibit perforation by a knife when food articles were cut upon it and a flexibility means for accommodating flexure of said mat into an arcuate trough shape having sufficient cantilever beam strength when flexed around a longitudinal centerline to support food articles. As to the lay flat characteristics, this property is inherent. Clearly the "Counter-Maid" mat had a hardness means, thickness means and flexibility means equivalent to those limitations contemplated by applicants, and a method for using a flexible cutting mat for food preparation, all of which was communicated to the applicant prior to the date that it can be shown that applicant possessed knowledge of the invention.

Rejection of claim 11, 35 U.S.C. 103

Applicants argue that the GB 2248177 reference (hereinafter the publication) is not prior art because the named inventor made the invention before the effective filing date of this reference, as evidenced by the Rule 131 declaration.

As set forth previously, there was no evidence of a Rule 131 declaration submitted with applicants' response. Also, it should be noted that the present application is filed as a C-I-P application and only those thicknesses of 0.008-0.030 inches would be awarded an earlier effective filing date. Claim 11 is not limited to thicknesses within this range. The declaration of John Cox has been noted but is not found to be convincing to overcome this rejection because claim 11 embraces thicknesses within the range disclosed by the publication. In fact, the

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declaration appears to suggest that thickness within the claimed ranges are not capable of flexing as alleged by applicants.

Applicants argue that “obvious to try” is not the standard under section 103(a) and that “in some cases, what would have been obvious to try would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. *In re O’Farrell*, 7 USPQ2d 1673 at 1681 (Fed. Cir. 1988).

In this regard, it is the position of the examiner that the teachings of “tough” and “tough enough to ensure that even sharp kitchen knives will hardly penetrate its surface”, and “the use of polypropylene in the specified thickness range has been found to provide a mat which is not easily cut by knives and yet is easily cleaned” and “which is flexible enough to be formed into a channel yet is rigid enough not to deform and cause unwanted food spillage” would have provided direction to the skilled artisan as to what parameters were critical, namely, the type of plastics material e.g. polypropylene, the hardness and thickness of said material, e.g. “tough” and the flexural modulus, e.g. “flexible enough”. This teaching in combination with the general level of ordinary skill and knowledge in the art of commercially available polypropylene would have provided a suggestion to the skilled artisan at the time the invention was made, to perform routine experimentations to choose and determine the specific polypropylene from commercially available polypropylene commensurate with the desired end properties and with a reasonable expectation of

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success of producing a flexible cutting mat for food preparation having means for resisting curling, hardness means, thickness means and flexibility means as required by claim 11, as well as the claimed critical hardness and flexural modulus. It should be noted that applicants have admitted on the record that the plastic sheet per se is not patentable.

Applicants argue that the examiner has used hindsight reasoning.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As set forth previously, the publication would have provided motivation to use polypropylene that is tough and able to withstand perforation by a knife, flexible, yet rigid to prevent deformation and unwanted food spillage.

Applicants argue commercial success of the claimed invention.

In this regard, it is the examiner's position that the evidence of commercial success is not commensurate in scope with the claimed invention. In particular, the evidence presented in related to flexible mats of thickness between 0.008 and 0.030 inches, whereas the subject matter defined by the invention embraces mats of thicknesses in the range of 0.030 inches up to 0.060 inches. While applicants do not have to show commercial success at every point within the

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claimed range, it should be noted that the record has established some undesirability of mats of thicknesses greater than 0.030 inches, (note applicants' comments in reference to the thickness range of 0.031-0.079 inches disclosed in the publication). Therefore, there is no clear nexus between the present claimed invention and the commercial success because there is no evidence that the product which has been sold corresponds to the claimed invention.

Applicants argue that the level of skill in the art is relatively low and that it is an error to consider obviousness from the point of view of a scientist or engineer having extensive knowledge of the vast array of plastics and their chemical and material properties, rather, obviousness must be considered from the point of view of one who develops cutting boards and similarly straight forward plastics articles. Furthermore, applicants argue that the combination of references presented in the present application results in hindsight reasoning.

In this concern, it is the examiner's position that regardless of the level of skill in a particular art, "Section 103 requires us to presume full knowledge by the inventor of the prior art in the field of his endeavor." *In re Winslow*, 151 USPQ 48 (CCPA 1966). Accordingly, it is the examiner's position that the level of ordinary skill in the art at the time the invention was made embraces the teachings of the publication of a method of using a flexible cutting mat for food preparation and said mat having a combination of properties that include being constructed from tough, flexible polypropylene in a thickness that inhibits perforation by a knife when food articles are cut upon it and that is rigid, yet flexible to prevent deformation and unwanted food spillage. Clearly the prior art contemplated a method of using a flexible cutting mat and said mat essentially

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as claimed in claim 11 and provided a suggestion and direction to the skilled artisan as to what parameters were critical in forming a flexible cutting mat, namely, polypropylene that was tough and flexible and thick enough to prevent perforation by a knife, and rigid enough to prevent deformation and unwanted food spillage. Arguments with respect to hindsight reasoning have been addressed previously.

Allowable Subject Matter

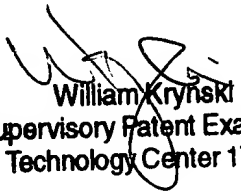
11. Claims 1-9 are allowed.

Conclusion

12. **THIS ACTION IS MADE FINAL.**

A shortened statutory period for reply to this final action is set to expire ONE MONTH from the mailing date of this action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. M. Gray whose telephone number is (703) 308-2381.


William Krynski
Supervisory Patent Examiner
Technology Center 1700


December 9, 1998